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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,988	01/16/2001	Kunio Arimoto	OPS Case 519	5747

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EXAMINER

UMEZ ERONINI, LYNETTE T

ART UNIT	PAPER NUMBER
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1765

9

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/761,988

Applicant(s)

ARIMOTO ET AL

Examiner

Lynette T Umez-Eronini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 7 and 8 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of claims 1-6 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 9, "The colored, transparent film-film forming composition according to Claim 1, consisting essentially of . . . a pigment" and

In claim 10, "The colored, transparent film-forming composition according to Claim 1, consisting of . . . a pigment" present new matter, which lacks support from the Specification.

"A consisting essentially of" claim occupies a middle ground between closed claims that are written in a consisting of' format and fully open claims that are drafted in

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a comprising' format." PPG Industries v. Guardian Industries, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998).

For search and examination purposes, absent a clear indication in the specification of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ at 1355 ("PPG could have defined the scope of the phrase consisting essentially of' for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On lines 2-6, "wherein said reaction product is one obtained by reaction between the epoxy group-containing alkoysilane (a-1) and the amino group-containing alkoxyasilane having active hydrogen (a-2) at a ratio by weight of 6:4 to 9:1" is indefinite

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because it is unclear what features are compared in the ratio. Is the ratio by weight representative of the active hydrogen in (a-2) or the hydrogen in (a-1) and (a-2)?

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-6, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nambu et al. (US 5,063,114).

Nambu teaches a topcoat clear coating (same as a colored, transparent film-forming composition) that comprises silane compounds, condensation products thereof, reaction products thereof or a mixture thereof of. Examples of the above silane compounds include  $\gamma$ -glycidoxypropyltrimethoxysilane (same as (a-1)) and N-( $\beta$ -aminoethyl)- $\gamma$ -aminopropylmethyldimethyl (same as (a-2)), (column 2, lines 16-17 and column 11, lines 15-21, 25-26, and 39), which reads on,

(a) a reaction product of an epoxy group-containing alkoysilane (a-1) and an amino group-containing alkoysilane (a-2) having active hydrogen therein;

a condensation catalyst such as sulfuric acid (column 11, lines 48-49), which the same as,

(b) an acid catalyst;

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UV absorber in an amount of 0.1 to 10 parts, per 100 parts of the solid components of the topcoat clear coating (column 12 lines 43-46) and that includes benzophenone and triazole (column 12, lines 2-27), which is the same as

(c) an alkali-soluble UV absorber;

a solvent for the topcoat includes n-amyl and octyl alcohol (column 8, line 53 – column 9, line 6) that has boiling points respectively of 137°C and 194-195°C (see Hawley's Condensed Chemical Dictionary), which reads on,

(d) at least one solvent selected from organic solvents having a boiling point of 100 to 250°C; and

(e) a dye and /or a pigment (column 12, lines 64-65 and column 13, lines 24).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nambu as applied to claim 1 above, and further in view of Ramesh (US 5,925,285).

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Nambu differs in failing to specify the weight ratio active hydrogen in the epoxy group-containing alkoysilane (a-1) to the amino group-containing alkoysilane (a-2) as 6.4 to 9.

Ramesh teaches the weight amounts of crosslinker component and polyfunctional epoxy compound will be dependent upon factors including, for example, the particular materials chosen, the presence of other reactive species as well as the desired end use. Based upon these variables and others, those of ordinary skill in the art should be able to adjust the composition of the coatings (including the relative amounts of the components) to achieve the desired effect (column 8, lines 25-33). Hence, the aforementioned provides evidence that varying the components of the coating composition is a so-called "result effective variable."

It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to modify the reactants of Nambu's coating composition by varying the weight ratio of the components of a coating composition as taught by Ramesh, which serves as evidence that varying the weight ratio of the components of a coating composition is a so-called "result effective variable," since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

10. Applicant's arguments filed January 14, 2002, should read January 14, 2003 have been fully considered but they are not persuasive. Applicant traverses the 102(b)

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rejection of claims 1 and 3-6 as being anticipated by Nambu. Applicant argues that although Nambu teaches an epoxy group containing alkoxysilane can be contained in the top coat clear coating as a hardening catalyst (C), the amino group containing alkoxysilane having active hydrogen contained therein is only disclosed as being an optional additive, hence Nambu has no specific disclosure or examples of a composition falling within the scope of claim 1. The applicant also argues that Nambu's polymer, which contains a hydroxyl group - containing acryl monomer as an indispensable component and includes a monomer other than a silicon-based monomer differs from that of the claimed invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the polymer is formed from an epoxy group - containing alkoxysilane monomer and an amino group-containing alkoxysilane monomer is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant traverses the 103 rejection of claim 2 as being unpatentable over Nambu in view of Ramesh. Applicant argues that Ramesh's film forming composition is neither silicon-based nor corresponds to any epoxy group-containing alkoxysilane of the present invention and fails to show the amino group-containing alkoxysilane having active hydrogen therein that is an essential component of the film-forming polymer of the present invention.



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Applicant's argument is unpersuasive because Ramesh is relied upon to provide evidence that varying the components of a coating composition is a so-called "result effective variable."

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hawley's Condensed Chemical Dictionary is relied upon to teach the boiling points of organic solvents.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

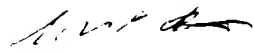
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynette T. Umez-Eronini whose telephone number is 703-306-9074. The examiner is normally unavailable reached on the First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech can be reached on 703-308-3836. The fax phone numbers for the organization where this application or proceeding is assigned are 703-972-9310 for regular communications and 703-972-9311 for After Final communications.

ltue  
March 15, 2003

  
BENJAMIN L. UTECH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER